



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

pw

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,515	10/07/2003	Kevin Benson McNeil	8846C	5037
27752	7590	03/03/2004	EXAMINER	
			EVANISKO, LESLIE J	
			ART UNIT	PAPER NUMBER
			2854	
DATE MAILED: 03/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/680,515	MCNEIL, KEVIN BENSON	

Examiner	Art Unit	
Leslie J. Evanisko	2854	<i>dw</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,6-8,10,11 and 14 is/are rejected.
- 7) Claim(s) 2-5,9,12,13,15 and 16 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 October 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20031007</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Priority

1. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. It is noted that applicant has included a statement reading "This is a continuation of Application No.10/050,276, filed January 16, 2002." as the first sentence of the specification. However, the current status of all nonprovisional parent applications referenced should also be included.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: reference numerals **100A** and **200A** in Figure 1. To correct this problem, it is suggested that the phrase "(not shown in the Figures)" in line 24 of page 8 be deleted and replaced with --**100A, 200A**, respectively--.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 6-8, 10-11, and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-14 of U.S. Patent No. 6,647,883. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both encompass a method for printing a liquid onto a sheet material comprising providing a porous printing surface with apertures, extruding a first liquid from the apertures onto the printing surface, applying a second liquid over and in contact with the first liquid on the printing surface, and contacting the sheet material with the printing surface to print the second liquid onto the sheet material.

With respect to claims 6-7, note claim 14 of US '883 teaches a film material and can broadly encompass either an individual sheet or a continuous web.

With respect to claims 8 and 14, note claim 12 of US '883.

With respect to claim 10, note claim 13 of US '883.

With respect to claim 11, note that claim 11 of US '883 renders obvious the apparatus for printing a liquid onto a sheet material as recited.

Allowable Subject Matter

5. Claims 1, 6-8, 10-11, and 14 would be allowable if the above set forth double patenting rejection is overcome.
6. Claims 2-5, 9, 12-13, and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or fairly suggest a method or apparatus for printing a liquid onto a sheet material including all of the method steps or structure as recited, in combination with and particularly including, providing a porous printing surface having apertures and contacting

the sheet material with the printing surface to print the second liquid onto the sheet material.

Note, in particular, the closest prior art is shown in Figure 8 of Yuasa et al. (US 5,132,706)--which is the corresponding U.S. Patent to EP 0 392 826--. However, the apparatus and method shown and described in Figure 8 of Yuasa et al. fails to teach or fairly suggest contacting the sheet material with the porous printing surface (which has the apertures) to print the second liquid onto the sheet material. Note that in Yuasa et al., the sheet material is contacted with the blanket cylinder 5 (or alternatively with the plate cylinder 3 directly as taught in column 5, lines 9-12) and therefore, Yuasa et al. do not teach or render obvious the step of contacting the sheet material with the porous printing surface having the apertures as recited.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leslie Evanisko
Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
February 19, 2004